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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/017,012	12/14/2001	Michael S.H. Chu	BSC-216 (1002/296)	7794

22852 7590 05/02/2006

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EXAMINER

THALER, MICHAEL H

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No. 10/017,012	Applicant(s) CHU ET AL.	
	Examiner Michael Thaler	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 and 20-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 and 20-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on Feb. 23, 2006 has been entered.

Claims 1-15 and 20-28 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no basis in the original disclosure for the limitation in claim 1, line 9 and claim 20, line 9 that the pivot is disposed substantially completely above a top surface of the base. As seen in figure 3B, when guide platform 230 is assembled onto base 220 (at the bottom of the figure) and the dashed lines indicating axis 218 are aligned, most of the pivot 234 is located below the top surface of base 220.

Claims 1-15 and 20-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-15 and 20-28 are confusing and inaccurate for the reasons set forth above.

Claims 20 and 22-28 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Zehnder (2,697,433). Zehnder discloses base (e.g. 36) defining an opening, outer rim 10, the base and the outer rim defining an aperture (shown best in figure 3) between the perimeter and the outer rim 10, guide platform (e.g. 46) disposed adjacent to the opening and rotatable about a rotation axis, the rotation axis extending through the opening and having a common point along the rotation axis, pivot 45 disposed above the base 36 (since the top of pivot 45 extends above the top surface of the base 36 to substantially the same degree as applicant's invention; i.e. slightly), guide shaft 44 disposed at least partially within the pivot 45 (figure 4), the guide shaft 44 comprising radiopaque material (col. 3, lines 52-58). Alternatively, it would have been obvious that pivot 45 is disposed above the base 36 for the reasons set forth above. As to claim 22, Zehnder discloses guide rod (e.g. 56 or 57) connected to the pivot (at least indirectly). As to claim 23,

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Zehnder discloses guide rod lock (col. 3, lines 22-28). As to claim 25, Zehnder discloses shaft 53.

Claims 1-15 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zehnder (2,697,433) in view of Ray (3,457,922). Zehnder discloses the guide shaft 44 comprising radiopaque material (col. 3, lines 52-58) between a first end (the upper end as seen in figures 1 and 2) and a locus along the guide shaft normal to the longitudinal axis at the common point (the ring shaped locus of points which form the circumference of guide shaft 44 at the center of pivot 45), the radiopaque material extending to the locus. Zehnder fails to disclose a material which is less radiopaque located immediately adjacent the locus. However, Ray teaches that the pivot ball (13 or 18) of a stereotaxic probe guiding apparatus should be X-ray transparent plastic (col. 3, lines 12-14) apparently in order to obtain the advantages of better seeing the probe with X-rays as well as enabling the ball to be compressible (col. 3, lines 1-3) in order to be easily locked in place. It would have been obvious to make the pivot ball 45 of Zehnder of a material that is less radiopaque so that it too would have these advantages. With this modification, Zehnder would have a material which is less radiopaque located immediately adjacent the locus as claimed. As to claim 12, the Zehnder outer rim 10 is inherently

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rotatable about the shaft axis prior to being fixed on the patient.

Applicant's arguments filed Feb. 23, 2006 have been fully considered but they are not persuasive for the reasons set forth above.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Thaler whose telephone number is (571)272-4704. The examiner can normally be reached Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan T. Nguyen can be reached on (571)272-4963. The fax phone number for the organization where this application or proceeding is assigned is (571)273-8300.

mht
4/27/06



MICHAEL THALER
PRIMARY EXAMINER
ART UNIT 3731